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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,606	12/22/1999	HEINZ PETER VOLLMERS	PATWA-2	5150
21559	7590	02/26/2004	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			HARRIS, ALANA M	
			ART UNIT	PAPER NUMBER
			1642	
DATE MAILED: 02/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/469,606

Applicant(s)

VOLLMERS ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments and Amendments

1. Claims 1, 4 and 42-44 are pending.
Claims 1 and 43 have been amended.
Claims 2, 3 and 5-40 have been cancelled.
Claims 1, 4 and 42-44 are examined on the merits.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Rejections

Claim Rejections - 35 USC § 112

3. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of the claim amendment and Applicants' remarks.

Claim Rejections - 35 USC § 102

4. The rejection of claim 43 under 35 U.S.C. 102(b) as being anticipated by Medof et al. (J. Exp. Med. 160:1558-1578, 1984), as evidenced by Hensel et al. (Cancer Res. 59:5299-5306, October 15, 1999/ reference AV on IDS) is withdrawn in light of the claim amendment.

Art Unit: 1642

5. The rejection of claim 43 under 35 U.S.C. 102(b) as being anticipated by Tsuji (U.S. Patent number 5,695,945, issued December 9, 1997), as evidenced by Hensel et al. (Cancer Res. 59:5299-5306, October 15, 1999/ reference AV on IDS) is withdrawn in light of the claim amendment.

Maintained Rejection

Claim Rejections - 35 USC § 112

6. The rejection of claims 1, 4 and 42-44 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 3, 39 and 40 have been cancelled.

Applicants aver, "one skilled in the art can readily distinguish CD55 lacking a tumor-specific glycostructure from one containing such a glycostructure". Applicants suggest that the amendments to the claims provide evidence that the presently claimed glycoprotein is clearly described in Applicants' specification. The Examiner has reviewed the specification in its entirety and carefully reviewed and considered Applicants' Remarks submitted the 9th of December 2003 and have found them unpersuasive.

The specification, as well as the Remarks is remiss of information detailing what defines tumor-specific glycostructure and how one of ordinary skill in the art could

Art Unit: 1642

identify the said structure. There is insufficient guidance regarding the section of the protein that is to have this specific structure. It is not clear how one of ordinary skill in the art could definitively recognize whether or not they were also in possession of Applicants' claimed invention, thereby infringing on Applicants' claimed invention. Applicants' claims continue to read on a genus. There is a plethora of species that could be encompassed by the broad claims. Applicants are not entitled to all proteins capable of exhibiting this structure or containing the amino acid primary structure of CD55. "For inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species *cannot* be achieved by disclosing only one species within the genus. Description of a representative number of species does not require the description to be of such specificity that it would provide individual support for each species that the genus embraces." See the Official Gazette, 1272 OG 174, January 30, 2001.

As set forth in the Request for Continued Examination mailed August 23, 2003, In *The Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that while Applicants are not required to disclose every species encompassed by a genus, the description of a genus is achieved by the recitation of a representative number of DNA molecules, usually defined by a nucleotide sequence, falling within the scope of the claimed genus. At section B(1), the court states that "An adequate written description of a DNA...requires a precise definition, such as by

Art Unit: 1642

structure, formula, chemical name, or physical properties', not a mere wish or plan for obtaining the claimed chemical invention".

There is insufficient to support the generic claims as provided by the Interim Written Description Guidelines published in the June 15, 1998 Federal Register at Volume 63, Number 114, pages 32639-32645.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571) 272-0831. The examiner can normally be reached between the hours of 7:00 am to 4:30 pm, with alternate Fridays off.

Art Unit: 1642

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne "Bonnie" Eyler, Ph.D. can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER



Alana M. Harris, Ph.D.
23 February 2004